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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/971,726	10/04/2001	Mark Thompson	020375-003600US	3054
20350 7590 01/10/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER ALI, MOHAMED HATEM	
			ART UNIT 3692	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/971,726

Applicant(s)

THOMPSON, MARK

Examiner

Mohamed H. Ali

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 30-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 30-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The following is a **final action** on merits in response to the communication received on **12/03/2007** with amendments to the claims as reflected in the listing and remarks.

#### ***Acknowledgement***

2. The claims **17-29** were **cancelled**. As such claims **1-16** and **30-38** are pending in the application.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-16 and 30-38** are rejected under 35 U.S.C. 102 (e) as being anticipated by ***Buchanan et al*** (7,216,106).

**As per claim 1**, *Buchanan* discloses a financial instrument, method comprising:

receiving an electronic package defining an image of the financial instrument (see **col.2**, lines 10-20; via electronic images of checks and items) at a first institution (see **col.1**, 30-36; via bank of first deposit) from a presenter (see **col.7**, lines 11-13; via bank of first deposit 101 receives a check from the bearer [presenter]), the image having been generated as part of a transaction at a point of sale (see **col.1**, lines 47- 51 and 22-26; **col.3**, lines 45-55; via deposit at a facility such as home or office[not bank] or computer-based software used at locations remote from financial institution offices for capturing deposit or remote location of businesses inherently retailing **POS**); and

crediting the presenter for funds in accordance with the financial instrument (see **col.3**, lines 53-56; via checks credited to the depositing individual's or organization's bank account).

**As per claim 2**, *Buchanan* discloses that the electronic package comprises the image (see **col.2**, lines 10-21; via collection of funds by processing electronic images of items inherently electronic package of images for clearing checks).

**As per claim 3**, *Buchanan* discloses the image is stored at a location within a depository and the electronic package comprises a reference to the location (see **col.2**, lines 34-55; via storing and item numbering information or unique number information back and forth [line 47] as reference number implying/ inherently any location on the list at the depository on the remote site processor).

**As per claims 4 and 5**, *Buchanan* discloses that the first institution comprises a financial institution or a bank (see **col.7**, **Fig.1**; via a bank of first deposit **101**).

**As per claims 6, 7 and 8, *Buchanan*** discloses transmitting the electronic package to a second institution wherein the second institution comprises a clearing institution and wherein the clearing institution comprises a reserve institution for recovery of the funds (see **col.8**, lines 26-31 and **Fig.2**; via Maker bank [2<sup>nd</sup> institution] site with **FRB 107**).

**As per claim 9, *Buchanan*** discloses that the second institution comprises a drawee financial institution that is identified from the electronic package (see **col.3**, lines 4-22; via complete deposit data [electronic package] used by central site of collection center for deposit from other institutions [maker bank - 2<sup>nd</sup> institution]).

**As per claim 10, *Buchanan*** discloses the first institution comprises a clearing institution (see **Fig.2**, maker bank site **199** with **107**).

**A per claim 11, *Buchanan*** further discloses provisionally crediting an account of the presenter and releasing the credited funds after recovery of the funds (see **col.3**, lines 50-55; credited to the deposing individual's account inherently after recovery of funds to change provisional).

**A per claim 12-13, *Buchanan*** discloses the first institution comprises a drawee financial institution identified by the financial instrument and the presenter comprises a clearing institution (see **col.7**, lines 11-32; via a bank of first deposit 101 deceives a check from the bearer [presenter] information includes maker bank account number and through FB check clearing processes).

**As per claim 14**, *Buchanan* discloses the image is encrypted, the method further comprises decrypting the image (see **col.32-45**; via check images stored and encryption to ensure privacy).

**As per claims 15-16**, *Buchanan* discloses that the financial instrument comprises a check and a credit-card sales slip (see **col.1**, lines 24-25; via the act of depositing or otherwise converting a financial instrument such as a check, draft, or other instrument [such as *credit-card sales slip*] has generally required the physical presentment of the instrument and **col.2**, lines, 44-45; via checks and deposit records or electronic information without the use of paper items).

**As per claims 30 and 34**, *Buchanan* discloses a computer-readable storage medium having a computer-readable program embodied therein for directing operation of a computer system for a first institution (**Fig.1**, a bank of first deposit **101**), the computer system including a communications system, a processor, and a storage device, wherein the computer-readable program includes instructions for operating the computer system to process a financial instrument (see **col.5 & 6**, lines 50-67 and 1-65 respectively) in accordance with the following:

receiving an electronic package defining an image of the financial instrument from a presenter with the communication systems, the image having been generated as part of a transaction at a point of sale (see **col.1**, lines 47- 51 and 22-26; **col.3**, lines 45-55; via deposit at a facility such as home or office [not bank] or computer-based software used at locations remote from financial institution offices for capturing deposit or remote location of businesses inherently retailing **POS**); and

crediting an account of the presenter for funds in accordance with the financial instrument (sees **col.3** , lines 50-55; credited to the depositing individual's account inherently after recovery of funds to change provisional).

**As per claims 31 and 35**, *Buchanan* discloses the computer-readable program further includes instructions for transmitting the image of the financial instrument to a second institution for recovery of the funds (see **col.6**, lines 1-2 and **col.7**, lines 10-32; via computer readable media and step **118** into a maker bank 108 for collection of funds).

**Claims 32 and 36**, are rejected as per the reasons set forth in **claim 3**

**Claims 33 and 38**, are rejected as per the reasons set forth in **claim 15**

**As per claim 37**, *Buchanan* discloses the financial instrument is adopted for connection with the Internet (see **col.2**, lines 32-3; via financial institution over telecommunication lines such as Internet etc.).

### ***Response to Arguments***

5. **Applicant's** arguments filed on 12/03/2007 have been fully considered but they are not persuasive.

**Applicants** argued (First & Second- related claims **3** and **36**) that," there is no teaching at the cited passages that item numbering information can be used as a reference to a location within a depository." **The Examiner** respectfully disagreed. As cited in **col.2**, lines 34-55, particularly on lines 46-47, as an alternative to the interactive

process, ***unique number information*** [ on banking record listing implied] back and forth, inherently may be treated as the reference number location at the depository.

**Applicants** further argued (Third- related claim **11**) that, “first provisionally crediting an account and then releasing the credited funds clearly do not necessarily occur in a single step of crediting checks to an account. Hence, the Office Action has failed to establish inherency.” **The Examiner** respectfully disagreed. The act of depositing or otherwise converting a financial instrument is the acceptance and processing of monetary instruments (see **col.1**, lines 24-29). “Otherwise known as the bank of first deposit, where the deposit may be accepted [ surly provisional] and credited to the bank customer’s account, of course , subject to the check **clearing** with maker financial institution”(see **col.1**, lines 33-36). So any check deposit is not the final crediting. It is the first step implied before clearing fund as the second step.

**Applicants** also requested for **clarification** (Fourth, - related claim **16**) that “a credit-card sales slip is clearly not the deposit slip retained by a depositor.” **The Examiner** clarifies with updated citation that the act of depositing or otherwise converting a financial instrument such as check, draft, or other instrument (which could be a **credit-card sales slip**) has generally required the physical presentment of the instrument (**col.1**, line 24-26).



***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohamed H. Ali whose telephone number is 571-270-3021. The examiner can normally be reached on 8.00 to 5.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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MA

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